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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,887	11/14/2003	Werner Knebel	5005.1064	1103
23280	7590	09/19/2005		
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018				
			EXAMINER PRITCHETT, JOSHUA L	
			ART UNIT 2872	PAPER NUMBER

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,887

Applicant(s)

KNEBEL ET AL.

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to Amendment filed August 1, 2005. Claim 1 has been amended, claims 6 and 7 have been cancelled and claims 12-20 have been added as requested by the applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-12 and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hakamata (US 5,065,008).

Regarding claims 1 and 12, Hakamata discloses a scanning microscope having a detector (25), arranged in a detection beam path (Fig. 1), for receiving detection light proceeding from a sample (20) and an optical shutter (23) means between the sample and the detector with which the detection beam path can be blocked (col. 7 lines 54-67) and the detection beam path is automatically blockable when the light power level of the detection light exceeds a definable threshold (col. 8 lines 31-39). Hakamata states that when the light is not directed to a certain

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location on the shutter means, thus the light power level exceeds a minimum threshold; the shutter is closed at that location.

Regarding claims 3 and 14, Hakamata discloses a descan detector (Fig. 1).

Regarding claims 4 and 15, Hakamata discloses a control means for controlling the shutter means (col. 8 lines 31-39).

Regarding claims 5 and 16, Hakamata discloses the detection beam path can be automatically opened up before the beginning of a scanning operation and blocked at the end of a scanning operation (col. 8 lines 31-39).

Regarding claims 8 and 17, Hakamata discloses a means for monitoring the light power level of the detection light and extrapolates future change over the time in the detection light power level (col. 8 line 61 – col. 9 line 7). Hakamata states that as the scanning progresses the shutter can get out of sync with the scanning process and can then be adjusted, thus anticipating changes in the power level with relation to the shutter means over time.

Regarding claims 9 and 18, Hakamata discloses the shutter means contains an LCD element (col. 7 lines 54-56).

Regarding claims 10 and 19, Hakamata discloses the detector contains a photomultiplier (col. 7 lines 54-56).

Regarding claims 11 and 20, Hakamata discloses the scanning microscope is a confocal scanning microscope (col. 7 lines 10-13).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hakamata (US 5,065,008) in view of Hanninen (US 5,523,573).

Hakamata teaches the invention as claimed but lacks reference to the use of a non-descan detector. Hanninen teaches a microscope having a detector (CCD) arranged in a detection beam path (Fig. 5) for receiving detecting light proceeding from a sample (N1) and an optical shutter (S1) means between the sample and the detector for which the detection beam path can be blocked (Fig. 5). Hanninen further discloses the detector is a non-descan detector (Fig. 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Hakamata invention include a non-descan detector for the purpose of detecting light reflected by the sample.

Response to Arguments

Applicant's arguments, see Amendment, filed August 1, 2005, with respect to the information disclosure statement have been fully considered and are persuasive. The objection

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of the information disclosure statement has been withdrawn. The applicant argued that the objection to the IDS should be withdrawn because a copy of the missing reference was submitted with the Amendment. The examiner reviewed the reference and a signed copy of the PTO-1449 accompanies this office action.

Applicant's arguments filed August 1, 2005 have been fully considered but they are not persuasive.

On page 6 of Amendment, applicant argues that the operation of the liquid crystal shutters of Hakamata are not based power level. The threshold that is exceeded does not have to be a maximum threshold that is surpassed, but could also be a minimum threshold which the intensity drops below. Hakamata uses the lower threshold to open only the shutters where the point (P) is currently located. The claim does not require that the shutters be dynamically responsive to the light. The claim only the light blockage be based on the level of detection. In Hakamata, when the light power level is below the power level at point (P) the light is blocked. Therefore the shutter position is based on the power level of the light at each shutter location.

On page 6 of Amendment, applicant argues that Hannien does not teach shutters based on the power level of the light. This limitation is taught by the Hakamata reference.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP



DREW A. DUNN
SUPERVISORY PATENT EXAMINER